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SERIAL NUMBER	REQUEST DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
10/501,107	2/1/06	MICHAEL GILLES, ET AL.	UMC.10015

Title: **PREPARATION OF STEEL SURFACES FOR SINGLE-DIP ALUMINUM-RICH ZINC GALVANISHING**

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Art Unit	Paper Number
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Correspondence Address:  
JOSHUA T. ELLIOT  
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Licensee under 35 U.S.C. 184 is hereby granted to file in any foreign country a patent application and any amendments thereto corresponding to the subject matter of this U.S. application identified above and/or any material accompanying the petition. This license is conditioned upon modification of any applicable secrecy order and is subject to revocation without notice.

License Number: 536,134

Grant Date: 27-Mar-06

**This license is granted retroactively to the date(s) and the country(s) indicated on the attached decision.**

Approved:

  
for Commissioner of Patents and Trademark

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This license does not empower the filing of any applications, amendments, supplements or continuances originating in this country which disclose inventions, modifications, or variations not disclosed in the subject matter identified above.

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**LICENSE FOR FOREIGN FILING**

[Title 35, United States Code (1952) Sections 184, 185, 186]



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
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WASHINGTON, D.C. 20231  
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Petitioner: GILLES, et al. :DECISION ON REQUEST  
Petition No.: 10/501,107 :UNDER 37 CFR 5.25  
Petition Filing Date: 01 February 2006  
Docket No.: UMC.10015

Title: PREPARATION OF STEEL SURFACES FOR SINGLE-DIP  
ALUMINUM-RICH ZINC GALVANISING

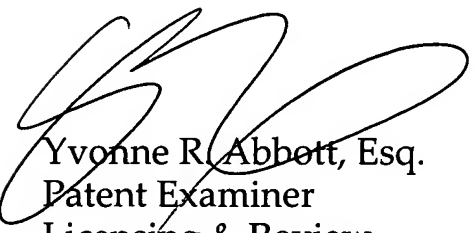
This is a decision on the petition for retroactive foreign filing license.

It has been determined that a retroactive license for foreign filing under 35 U.S.C. 184 be granted with respect to the filing(s) listed below. The petition complies with 37 C.F.R. 5.25 in that there is an adequate showing that the subject matter in question was not under secrecy order, that the license was diligently sought, and that the material was filed abroad without the required license under 37 C.F.R 5.11 through error and without deceptive intent.

Foreign Filing Location

Date

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SEE APPLICANTS' APPENDIX I

  
Yvonne R. Abbott, Esq.  
Patent Examiner  
Licensing & Review  
(571) 272-6896

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## APPENDIX I

Country: Europe

Filing Date: January 10, 2002

Application No.: EP 02075073.3

Country: International Application filed in the European Patent Office

Filing Date: November 20, 2002

Application No.: PCT/EP02/13329

Country: Australia (national stage of PCT/EP02/13329)

Filing Date: July 1, 2004

Application No.: AU20020352160

Country: Brazil (national stage of PCT/EP02/13329)

Filing Date: July 7, 2004

Application No.: BR20020015496

Country: Canada (national stage of PCT/EP02/13329)

Filing Date: October 27, 2004

Application No.: CA20022479610

Country: Europe (national stage of PCT/EP02/13329)

Filing Date: June 10, 2004

Application No.: EP 02787835.4

Country: Morocco (national stage of PCT/EP02/13329)

Filing Date: June 29, 2004

Application No.: MA20040027751

Country: Poland (national stage of PCT/EP02/13329)

Filing Date: July 7, 2004

Application No.: PL20020369648

Country: South Africa (national stage of PCT/EP02/13329)

Filing Date: June 17, 2004

Application No.: ZA20040004797

Application No.: 10/501,107

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Country: India (national stage of PCT/EP02/13329)

Filing Date: June 16, 2004

Application No.: 828/KOLNP/2004

Country: Mexico (national stage of PCT/EP02/13329)

Filing Date: June 9, 2004

Application No.: PA/A/2004/006699

Country: Philippines (national stage of PCT/EP02/13329)

Filing Date: June 18, 2004

Application No.: 1-2004-500930

Country: Ukraine (national stage of PCT/EP02/13329)

Filing Date: August 10, 2004

Application No.: 20040806607

Patent  
Attorney Docket No. UMC.10015

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Michael GILLES et al.

Mail Stop L&amp;R

Application No.: 10/501,107

Group Art Unit: 1762

Filing or 371(c) Date: July 8, 2004

Examiner: Alain L. Bashore

Title: Preparation of Steel Surfaces for Single-Dip Aluminum-Rich Zinc Galvanising

Confirmation No.: 1703

**PETITION FOR RETROACTIVE FOREIGN FILING LICENSE  
UNDER 37 C.F.R. § 5.25**

Mail Stop L&R  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**RECEIVED**  
FEB 03 2006  
LICENSING & REVIEW

Sir:

Applicants hereby petition for a retroactive foreign filing license under 35 U.S.C. § 184 and 37 C.F.R. § 5.25 for U.S. Application No. 10/501,107, which is the national stage of International Application No. PCT/EP02/13329 (filed on November 20, 2002) and which has a 35 U.S.C. § 371(c) date of July 8, 2004. The application is entitled "Preparation of Steel Surfaces for Single-Dip Aluminum-Rich Zinc Galvanising" and names Michael Gilles, David Leychkis, Yumé Grot, and Roger Pankert as inventors.

In order to comply with 37 CFR §§ 5.25 (a)(1) and (2), a listing of (1) each of the countries in which the material set forth in application No. 10/501,107 was filed and (2) the date on which the material was filed in each country is attached in Appendix I. The application number for each of the filings is also listed in Appendix I.

In accordance with 37 CFR § 5.25 (a)(3)(i), a Declaration is attached from Joshua T. Elliott, attorney of record in the above-identified U.S. application, containing an averment that the subject matter in question is not currently under a secrecy order.

In accordance with 37 CFR §§ 5.25 (a)(3)(i) and (iii), a Declaration is attached from André Pilate, the registered European Patent Attorney who filed and caused to be filed the proscribed foreign filings, containing:

(1) an averment that the subject matter in question was not under a secrecy order at the time it was filed abroad, and

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(2) an explanation of why the material was filed abroad through error and without deceptive intent without the required license under § 5.11 first having been obtained.

In accordance with 37 CFR § 5.25 (a)(3)(ii), the facts in the attached Declarations contain a showing that the retroactive foreign filing license has been diligently sought after discovery of the proscribed foreign filings.

#### Summary of Facts

A summary of the facts averred in the attached Declarations from André Pilate and Joshua T. Elliott is set forth below.

André Pilate, as an employee of Umicore (the owner of the above-identified application), filed European Application No. 02075073.3 on January 10, 2002 and filed International Application No. PCT/EP02/13329 on November 20, 2002.

On June 7, 2004, André Pilate sent a letter to Burns, Doane, Swecker & Mathis LLP requesting that International Application No. PCT/EP02/13329 be entered into the U.S. national stage. André Pilate also sent letters to patent agents/attorneys in Australia, Brazil, Canada, Morocco, Poland, South Africa, India, Mexico, Philippines, and Ukraine requesting that national stage applications be filed in those countries; these national stage applications were filed on July 1, 2004, July 7, 2004, October 27, 2004, June 29, 2004, July 7, 2004, June 17, 2004, June 16, 2004, June 9, 2004, June 18, 2004, and August 10, 2004, respectively. On June 10, 2004, André Pilate filed a request to enter International Application No. PCT/EP02/13329 in the European Regional Phase. On July 8, 2004, Joshua T. Elliott of Burns, Doane, Swecker & Mathis LLP filed the documents required to enter International Application No. PCT/EP02/13329 in the U.S. national stage.

On June 16, 2005, André Pilate, Guy Knockaert, and Jos Roosen (all employees of Umicore's Patent Department in Olen, Belgium) met with Joshua T. Elliott and Allen Baum, both now of Hutchison & Mason PLLC, and discussed, among other things, 35 U.S.C. § 184 as part of an educational presentation concerning U.S. patent law. Prior to speaking with attorneys at Hutchison & Mason, André Pilate was not aware of the requirement under 35 U.S.C. § 184 for obtaining a foreign filing license for an invention made in the United States before filing patent applications in countries outside of the United States.

Based on the meeting between the members of Umicore's Patent Department and attorneys from Hutchison & Mason PLLC, Umicore conducted an internal review of their patent applications to determine whether there were any applications with subject matter that may have been invented in the United States. In July 2005, the invention claimed in the above-identified application was identified as potentially being at least partly invented in the United States.

During July and August 2005, Jos Roosen (on behalf of Umicore's Patent Department) exchanged e-mail correspondence with Joshua T. Elliott to gather more information about the process

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and cost for correcting the inadvertent mistake of filing the subject matter of the above-identified application in foreign countries without having a foreign filing license from the Commissioner of Patents. After this information was gathered, Umicore's Patent Department initiated an internal review and discussion with the business unit of Umicore responsible for the above-identified patent application, the corresponding foreign applications, and the subject technology to determine whether to pursue the U.S. application and a petition for a retroactive foreign filing license for the U.S. application as well as whether to pursue the foreign applications directed to the same subject matter.

On January 17, 2006, Guy Knockaert (on behalf of Umicore's Patent Department) asked Joshua T. Elliott to prepare a petition for a retroactive foreign filing license to be filed at the U.S. Patent and Trademark Office. Further discussion on January 31, 2006 between André Pilatc, Guy Knockaert, Joshua Elliott, and Allen Baum confirmed that subject matter claimed in the above-identified application was in fact at least partially invented in the United States.

#### Conclusion

For the reasons stated above and set forth in the attached Declarations, the requirements of 37 CFR § 5.25, including §§ (a)(3)(i), (ii), and (iii), have been met.

Please charge the fee of \$200.00 required under 37 CFR § 5.25 (a)(4) and 37 CFR § 1.17(g) to Deposit Account No. 50-3218. The Director is hereby authorized to charge any appropriate fees that may be required by this paper, and to credit any overpayment, to Deposit Account No. 50-3218.

Respectfully submitted,

HUTCHISON & MASON PLLC

Date: February 1, 2006

By: Joshua T. Elliott

Joshua T. Elliott

Registration No. 43,603

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I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on February 1, 2006  
(Typed Name and Signature of Person Signing Certificate) Jennie Shead Date of Signing: 02/01/2006

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